

REMARKS/ARGUMENTS

In response to the Office Action mailed March 9, 2007, Applicant amends his application and requests reconsideration. In this Amendment claims 6-9 are cancelled and new claims 21-24 are added so that claims 1-5 and 10-24 are now pending.

In the specification, the second paragraph is updated. References to certain figures are amended to conform to other parts of the patent application. In addition, a minor punctuation error is corrected.

Formality Rejections

All examined claims were rejected as indefinite. Applicant responds to each of these rejections.

The assertion that the acronyms IC and ID are indefinite is not reasonable considering common knowledge in the art and the absence of any such requirement in the prosecution of the parallel patent application mentioned in the second paragraph of the present specification. Nevertheless, these terms are identified, as demanded, in the amended claims.

The phrase in claim 1 regarding the transmission of the tag ID and the detector ID is clarified. The question as to whether they are transmitted separately or together has no relevance to the claim nor to its clarity.

The assertion that the phrase "at a time at which the detector has detected" is indefinite needs no reply since that language never appeared in claim 1.

The final paragraph of claim 1 no longer is open to an assertion of indefiniteness based upon potential double inclusion.

Claims 7 and 9 are no longer pending so that the assertion that these claims are indefinite is moot. However, the fundamental basis of the issue raised is shown to be erroneous in the discussion that follows.

Claim 10 has been clarified to explain that the user of the system can be either a customer of the hotel or a staff member employed by the hotel. There was no intent to suggest that a person can be both a customer and a staff member simultaneously.

Section 101 Rejection

Examined claims 7 and 9 were rejected as indefinite and as attempting to simultaneously claim subject matter in two different statutory classes. Although claims 7 and 9 are no longer pending, the limitations from those claims, as explained below, appear in modified form in new claims 13 and 18. Accordingly, it is appropriate to respond to the two rejections made with respect to those claims.

In rejecting those claims as to form, the Examiner stated that “the applicant has recited method-like limitations, but have [sic] written them in a descriptive way, of how the system limitations of [sic] are intended to work, or tasks they are intended to perform.”

For decades, U.S. patent applications have been prosecuted with such claim limitations. Seasoned examiners recognize these limitations not as “method-like”, but as functional limitations. Functional limitations are described and their acceptability is set forth at MPEP 2173.05(g). A functional limitation properly characterizes a claim element by explaining that the element reacts to stimulus A with response B. That characteristic is not a method step, it is a description of what is claimed.

There is no basis for objecting to the form of these claims and the functional limitations do not make the claims indefinite, as shown by the cited MPEP section. Moreover, it is apparent from the portion of the Office Action directed to prior art rejections that the Examiner has chosen to ignore the functional limitations in claims 7 and 9 that have been erroneously classified as “method-like”. The Examiner is without authority to refuse to examine or give patentable weight to these limitations. Such authority is granted only with respect to process limitations, in some instances, in product-by-process claims.

The assertion that claims 7 and 9 incorporated subject matter in two different statutory classes of patentable subject matter is an example of a serious error propagating through the junior examining corps of the U.S. Patent and Trademark Office. The error can be quickly dispelled, but not by studying MPEP 2173.05(b)II, the applicable section. The explanation there is seriously deficient with respect to the concept of attempting to encompass within a single claim limitations directed to both an apparatus and a method of operating the apparatus. The best explanation of the concept and its application is a brief portion of a recent opinion, the only Federal Circuit opinion on point, *IPXL Holdings v. Amazon.com, Inc.*, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005).

The important part of that opinion is the reproduction of the part of the dependent claim that was held invalid as indefinite for encompassing two different statutory classes of subject matter.

“The system of claim 2 [including an input means] wherein the predicted transaction information comprises both a transaction type and transaction parameters associated with that transaction type, and *the user uses the input means* to either change the predicted transaction information or accept the displayed transaction type and transaction parameters.”

The crossing of statutory classes in that claim is readily apparent, even without the emphasis supplied by the Federal Circuit. It is likewise equally apparent that no such mixture of different classes of statutory subject matter was present in claims 7 or 9 or in any claim now pending. Instead, functional limitations, approved by the MPEP and in use for years in valid claims in U.S. patents, appeared in claims 7 and 9. Those functional limitations do not traverse the boundaries between statutory classes of subject matter and are not open to rejection either under 35 USC 112 or 35 USC 101, under any provision of the MPEP, or under established law. See, *IPXL Holdings*.

Claim Amendments

In this Amendment, in addition to the clarifications mentioned above, further clarifications are made in the claims. In addition, examined claims 1 and 3 are combined as amended claim 1. This claim now specifies that the tag comprises a detachable sticker.

New independent claims 13 and 18 are derived from combinations of examined claims 1, 6, and 7, and claims 1, 8, and 9, respectively. In constructing these combined claims, in view of the inappropriate rejections of claims 7 and 9, revisions have been made to describe the search function in terms of a search device. These new claims are clearly supported by the examined claims. Moreover, the search device and functions are described in the patent application from page 33, line 1 through page 41, line 3. This disclosure clearly supports the new independent claims. Examined dependent claim 3 is amended to depend from claim 13. New dependent claims 14-17 are derived from examined claims 4, 5, 10, and 12. New dependent claims 19-24 are derived from examined claims 3-5 and 10-12.

Prior Art Rejections

The prior art rejections are discussed with respect to the three pending independent claims. If those claims are patentable over the prior art applied in the examination, then, clearly, their respective dependent claims are likewise patentable.

Amended claim 1, as previously explained, is based upon examined claims 1 and 3. Although examined claim 1 was rejected as anticipated by Shore (U.S. Patent 6, 225,906), claim 3 was rejected only as obvious over Shore. Therefore, it is presumed that amended claim 1 might be subjected to an obviousness rejection based upon Shore considered by itself.

In rejecting examined claim 3, the Examiner acknowledged that Shore fails to disclose a tag that comprises a detachable sticker. To fill this gap, the Examiner asserted that "it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the tag include a detachable sticker...".

Several errors appear in this assertion. First, a naked assertion that a difference between a claimed invention and the prior art is "an obvious design choice" is legally insufficient to reject the claim. Claim rejections require factual information demonstrated to be within the knowledge of those of skill in the art or to be present in a prior art publication. See, *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

Second, there is no suggestion in Shore that the tag described there could be or should be a detachable sticker. In fact, the teaching in Shore is entirely to the contrary.

According to a passage in column 5 of Shore,

"The tag 18 is hypo-allergenic, small, lightweight, water-resistant, and easily sterilized for reuse. The tag 18 also includes a selective locking latch for releasably securing the tag 18 to a person or object to be monitored." (Shore at column 5, lines 60-64.)

Shore expressly describes as a requirement of the tag the existence of a selective locking latch. Further, throughout Shore, it is required that this locking latch include an electronic function so that an attempted cutting, removal, or substitution for the tag is an event results in transmission of an alarm to a person monitoring objects or hospital patients that carry a tag. This description is entirely inconsistent with using a "sticker".

The term "sticker" means "one that sticks", "a gummed or adhesive label or patch". These commonly understood meanings are inconsistent with the existence of a latch as in Shore's tags. Moreover, Shore requires, because of its usage of the tags 18 in a hospital environment, that the tags be water-resistant and easily sterilized. It is not reasonable to expect a sticker, which, by definition, involves an adhesive, could be sterilized without requiring replacement of the adhesive.

In other words, the only way one could transmute the tag 18 of Shore into the detachable sticker of amended claim 1 is by use of knowledge of the invention. Reliance upon knowledge of the invention to reject a claim is legally impermissible.

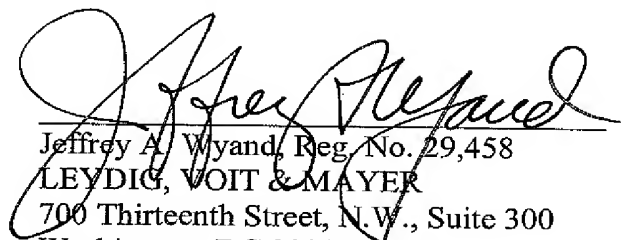
Therefore, upon reconsideration, amended claim 1 and all of its dependent claims should be allowed.

Both of the new independent claims, claims 13 and 18, describe a system that includes a searching device. The basis of operation of the searching devices is different in the two claims. Shore never describes any searching function. Instead, what is described by Shore is an analysis of past events or the sounding of an alarm when a patient is transported without permission or travels into a restricted area. That kind of system, sounding an alarm before a person becomes "lost", i.e., outside a permitted area, precludes the necessity of searching for a person who has become lost. Of course, in the invention, it is a chattel, i.e., a belonging or article, that includes the tag and that is searched for, not a person.

In any event, for the reasons just discussed, there is no suggestion in Shore for a tracking system with a search function as described in claims 13-24 and 2. Therefore, those claims are clearly patentable over Shore. Of course, for the same reasons already advanced with respect to amended claim 1, dependent claims 3 and 19 are separately patentable over Shore, independent of the patentability of claims 13 and 18.

Reconsideration and allowance of all claims now pending are earnestly solicited.

Respectfully submitted,



Jeffrey A. Wyand, Reg. No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960

(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date: July 19, 2007
JAW:ves